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EXAMINER
RHODES, J

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 08/655,136

Filing Date: 5/30/96

Appellant(s): Bruce Tognazzini

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Group 2700

Eugene J. Molinelli
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 1/25/99.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct. The examiner acknowledges that the appeal from the rejection of claim 16 is hereby withdrawn.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-15 and 17-20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Group I, claims 1-3 and 18.

Group II, claim 4.

Group III, claims 5-8 and 10.

Group IV, claim 9.

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Group V, claim 11.

Group VI, claim 12.

Group VII, claim 13.

Group VIII, claim 14.

Group IX, claim 15.

Group X, claim 17.

Group XI, claim 19.

Group XII, claim 20.

(8) *Claims Appealed*

A substantially correct copy of appealed claims 1-15 and 17-20 appears on pages 18-22 of the Appendix to the appellant's brief. The minor errors are as follows: claim 16 is listed as an appealed claim even though appellant's brief has stated that appeal from claim 16 is withdrawn, and in claim 17, line 3, "medium,;" should be replaced with "medium;".

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

✓5,195,130	Weiss et al	3-1993
✓5,455,407	Rosen	10-1995
✓5,452,352	Talton	9-1995

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(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-15 and 17-20 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office action, Paper No. 5.

(11) *Response to Argument*

In the arguments, applicant argues in substance that: (1) neither Weiss, Rosen, nor Talton teach that the customer information that is sent to the seller is returned and stored in a memory in the customer telephone-computer as recited in claims 1, 5, 11, 13, 15, and 17; (2) neither Weiss nor Rosen teach the “plurality of data memories and...corresponding...keys...to send information stored” as recited in claim 4; (3) Neither Weiss nor Rosen teach a credit card reader for “credit card information” recited in claims 19 and 20; (4) neither Weiss nor Rosen teach “a portable device” for “sending said information to a seller” as recited in claim 12; (5) neither Weiss nor Rosen teach checking if the customer is memory equipped as recited in claims 13-15; (6) the limitation that “the information is keyed in by personnel” in claim 15 should be given patentable weight; (7) there is no technical reason or motivation to combine Weiss and Rosen; (8) there is no technical reason or motivation to combine Talton and Weiss.

In response to applicant's argument in point (1) that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., customer information sent to the seller is returned and stored in a memory in the customer site)

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are not recited in claims 1, 5, 11, 13, 15, and 17. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claims 1, 5, 11, and 15 do not require that the information sent from the seller to the customer be the same as information sent from the customer to the seller. The claims merely recite that information sent from the seller is stored by the customer. Although applicant argues that claim 5 recites "card information received from a seller" which the specification makes clear originates at the base station, this is a limitation from the specification which is not read into the claim. Although claims 13 and 17 recite "sending said information from said seller to...said customer," the "said information" can be easily interpreted as the information recited in the preamble of the claims.

In any case, both Rosen and Weiss teach the limitation in point (1). Weiss discloses that the customer wants to determine an account balance (col. 13 lines 57-65 and cols. 23-24). The customer contacts the bank service computer via the network host computer and is sent the account balance stored at the bank. How does the bank receive the account balance information? The account balance is information that has been sent to the bank from the customer via the deposits and withdrawals made by the customer. The account balance sent from the bank to the customer is obviously stored in a memory at the seller terminal in order for it to be displayed to the seller. Rosen also teaches that the electronic notes sent to the customer from the seller (bank) includes amount of the note (col. 19 lines 61). How did the

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bank come up with this number? Did the bank arbitrarily come up with an amount the customer might need? No, the customer sends to the bank the information regarding the amount which is needed, and this information is sent back to the user in the electronic note.

As to point (2), Fig. 3 of Rosen discloses a "PAY" key on a portable device which houses a transaction money module and is connected to a network (see col. 9 lines 56-65). Rosen discloses transaction money modules are connected to telephone links to transfer the notes (col. 8 lines 13-23). In addition, Weiss also discloses a plurality of speed dial keys (col. 6 lines 3-6). Dialing numbers on a touch-tone phone is a well known way of sending information to automated phone systems, and can therefore be used to send information such as account numbers to service computers.

As to point (3), "credit card information" is mere data. It is a number and is not given any more patentable weight. Applicant argues that this number provides functionality, but does not disclose what this functionality is. A number does not provide functionality. A machine provides functionality by doing something with the number. In addition, Weiss discloses sending account information to the bank service computer (col. 23 line 64 - col. 24 line 2). Credit card information is merely information about a credit account a user holds with a financial institution. It is merely account information, just like the account information disclosed in Weiss.

As to point (4), the portable device of Rosen sends electronic notes (col. 8) that include the value of the note (col. 19) which originates from the customer's base station.

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As to point (5), checking whether a called station is memory equipped is a function performed by every modem. The session establishment performed by the network host computer of Weiss (col. 25 line 45 - col. 26 line 12) and the communication session manager and network sign-on manager of Rosen (col. 18 lines 48-54) establish a connection between stations only if the stations are properly equipped with memory. These mechanisms would not allow someone using a conventional telephone to establish a session with another station.

As to point (6), the limitation that information is "keyed in by personnel" does not give the information any patentable weight over any other number. A number is still a number, no matter if it is transmitted over a network and stored, or keyed in by an operator and stored. The telephone at a seller site in claim 15 will treat either type of number the same. In addition, it was well known in the art to key in customer information in the bank service computers disclosed by Weiss, because many account transactions are performed in person by customers at the bank.

As to point (7), Weiss discloses that account numbers and secret access codes are transmitted via the network to the bank service computer (col. 23 line 64 - col. 24 line 2). Credit card numbers are also account numbers. If a credit card number or an account number and secret access code are intercepted, a criminal can use these numbers to perform fraudulent transactions using any computer with an Internet connection. Also, the customer whose account number was intercepted would not know about it until it was too late. Even if these numbers are read from a smart card, they are still transmitted over the network. Rosen, on the

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other hand, discloses that a customer's electronic notes cannot be used outside of the customer's money module (see col. 21 lines 37-41). The would-be criminal would have to gain access to the customer's money module in order to use the electronic notes. The customer would probably realize that the money module is gone much more quickly than realizing that account numbers were intercepted. By implementing the electronic notes of Rosen as a method of payment in the system of Weiss, the user will have added security because even if someone intercepts and deciphers the information sent on the network, the customer's account is still safe from fraud. The improvement in security constitutes proper motivation for combining the references.

In response to applicant's argument in point (8) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the docking port and method of loading data disclosed by Weiss to the device of Talton is to allow the data from an external memory to be transferred to the portable device without having to type in the transferred data manually. None of the data stored in the external memory has to be typed into the portable device of Talton when such a combination is made. If the teachings of Weiss to Talton, then


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the only way to transfer data from an external memory to the memory in the portable device of Talton would be to type it in manually. A practical application of the combined teachings of Talton and Weiss is to allow a user to transfer a set of phone numbers found using an Internet directory to the portable device without forcing the user to manually type these numbers into the portable device.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jason Rhodes
March 28, 1999



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